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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/724,011	11/26/2003	Christoph Heer	2002 P 10624 US	7561
48154	7590	03/28/2007		
SLATER & MATSIL LLP 17950 PRESTON ROAD SUITE 1000 DALLAS, TX 75252			EXAMINER COUGHLAN, PETER D	
			ART UNIT	PAPER NUMBER
			2129	
SHORTENED STATUTORY PERIOD OF RESPONSE		MAIL DATE	DELIVERY MODE	
3 MONTHS		03/28/2007	PAPER	

Please find below and/or attached an Office communication concerning this application or proceeding.

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

Office Action Summary	Application No. 10/724,011	Applicant(s) HEER, CHRISTOPH	
	Examiner Peter Coughlan	Art Unit 2129	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 19 January 2007.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-14 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-14 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 11/26/2003 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
 Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--------------------------------------------------------------------------------------|-------------------------------------------------------------------|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

Detailed Action

1. This office action is in response to an AMENDMENT entered January 19, 2007 for the patent application 10/724011 filed on November 26, 2003.
2. All previous office actions are fully incorporated into this Non-Final Office Action by reference.

Status of Claims

3. Claims 1-14 are pending in this application.

Drawings

4. The drawings are objected to because all elements in the figures and flow-charts are required to be distinctly labeled with appropriate legend. 37 CFR 1.84 (o).
Correction is required. The only drawing of the invention is objected to. This drawing supposedly comprises registers, comparators, multiplexers and control blocks all which have standardized shapes associated with them. All circuit schematic drawings, follow this standard, wherein the applicant's drawings, everything in the applicant's figure is a rectangle. In addition, the connections between these devices are unclear to the point such that it makes no sense. There are two 'multiplexers' (shown with the improper

symbol) and the input to the comparators is also connected to the multiplexers. It does not make sense that the multiplexer and the comparator receive the same data as an input. The control block itself needs to be diagramed in standardized form as well. It cannot be determined if the so called 'control blocks' are hardware or software because the applicant specification has no information concerning the contents of the logic control block. Another problem of the control block is the input '10' has three inputs but they only lead into the clock portion of the control block. Why does the clock input of the control block need three inputs? The applicant states that the circuit parallels an 'if-then-else' branch. If the applicant means this is equivalent to the 'if-then-else' statement in computer programming languages, there is no need for the output of the two multiplexers to go through the control block. The applicant desires a patent without detail of the invention is unacceptable.

The drawings are objected to under 37 CFR 1.83(a) because they fail to show The contents of the logic control block as described in the specification. Any structural detail that is essential for a proper understanding of the disclosed invention should be shown in the drawing. MPEP § 608.02(d). Corrected drawing sheets in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. The figure or figure number of an amended drawing should not be labeled as "amended." If a drawing figure is to be canceled, the appropriate figure must be removed from the replacement sheet, and where necessary, the remaining figures must

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be renumbered and appropriate changes made to the brief description of the several views of the drawings for consistency. Additional replacement sheets may be necessary to show the renumbering of the remaining figures. Each drawing sheet submitted after the filing date of an application must be labeled in the top margin as either "Replacement Sheet" or "New Sheet" pursuant to 37 CFR 1.121(d). If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance. There is no schematic design of the logic control block. It is a rectangle with 'connections' to it. There is no indication of direction which information inputs or outputs the logic control block. There is no description of the contents of the logic control block.

35 USC § 101

3. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

Claims 1-14 are rejected under 35 U.S.C. 101 for nonstatutory subject matter.

The computer system must set forth a practical application of that § 101 judicial exception to produce a real-world result. Connections between registers, comparators, multiplexers, input nodes, a control block are claimed to make up an 'if-then-else' branch has no practical application. The result has to be a practical application. Please see the interim guidelines for examination of patent applications for patent subject matter eligibility published November 22, 2005 in the official gazette.

In determining whether the claim is for a "practical application," the focus is not on whether the steps taken to achieve a particular result are useful, tangible and concrete, but rather that the final result achieved by the claimed invention is "useful, tangible and concrete." If the claim is directed to a practical application of the § 101 judicial exception producing a result tied to the physical world that does not preempt the judicial exception, then the claim meets the statutory requirement of 35 U.S.C. § 101. There is no real world practical purpose for such a hardware device stated within the application. It is just a collection of circuits, which the applicant claims parallels a if-then-else branch.

The invention must be for a practical application and either:

- 1) specify transforming (physical thing) or
- 2) have the FINAL RESULT (not the steps) achieve or produce a useful (specific, substantial, AND credible), concrete (substantially repeatable/ non-unpredictable), AND tangible (real world/ non-abstract) result.

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A claim that is so broad that it reads on both statutory and non-statutory subject matter, must be amended, and if the specification discloses a practical application but the claim is broader than the disclosure such that it does not require the practical application, then the claim must be amended.

A collection of circuits is not a practical application. Applicant states the existence of inputs and a output but there is no functionality for the comparison between two values stated within the claims or specification. There must be a result that is a practical application for the invention.

Claim Rejections - 35 USC § 112

4. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claims 1-14 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. This invention claims to parallel a 'if-then-else' branch. The problem with the description within an 'if-then-else' branch there is only one comparison expression which results in a Boolean answer. If the result is 'true' then the portion following the 'if' is executed and the portion following the 'else' is

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disregarded. If the result is 'false' then the portion following the 'if' is disregarded and the portion following the 'else' is executed. Therefore there is no need for a second comparator or a second multiplexer. There is also no need for the results of both multiplexers going back into the 'control box.' This invention does not provide a 'if-then-else' branch.

Response to Arguments

5. Applicant's arguments filed on January 19, 2007 for claims 1-14 have been fully considered but are not persuasive.

6. In reference to the Applicant's argument:

Claims 1-14 are pending in the present application. Claims 1, 2, 3, 5, 8, 10, 11 and 14 have been amended. No new matter has been added.

This amendment is being filed concurrently with an Appeal Brief to correct minor errors discovered while preparing the brief. Neither applicant nor the Examiner found these minor errors earlier.

This amendment presents the rejected claims in better form. No new issues are raised and entry of this amendment has no affect on the arguments raised in the brief.

Examiner's answer.

These amended claims are not due to an error by the applicant nor the Examiner but change the realm of the claims from the abstract to the concrete. With these claims raises new issues of the schematic diagram drawing of the invention which is insufficient and vague. The applicant is now required to supply corrected drawings with

standardized symbols which indicates stated circuits and connections between them, including the interior of the 'control logic block.'

Conclusion

4. Claims 1-14 are rejected.

Correspondence Information

5. Any inquiry concerning this information or related to the subject disclosure should be directed to the Examiner Peter Coughlan, whose telephone number is (571) 272-5990. The Examiner can be reached on Monday through Friday from 7:15 a.m. to 3:45 p.m.

If attempts to reach the Examiner by telephone are unsuccessful, the Examiner's supervisor David Vincent can be reached at (571) 272-3080. Any response to this office action should be mailed to:

Commissioner of Patents and Trademarks,

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Washington, D. C. 20231;

Hand delivered to:

Receptionist,

Customer Service Window,

Randolph Building,

401 Dulany Street,

Alexandria, Virginia 22313,

(located on the first floor of the south side of the Randolph Building);

or faxed to:

(571) 272-3150 (for formal communications intended for entry.)

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have any questions on access to Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll free).



Peter Coughlan

3/26/2007

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